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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,518

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Olaf Pichler

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EXAMINER

CURS, NATHAN M

ART UNIT

PAPER NUMBER

2613

MAIL DATE

DELIVERY MODE

08/02/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/572,518	Applicant(s) PICHLER ET AL.
	Examiner NATHAN CURS	Art Unit 2613

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 July 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: 19.
- Claim(s) rejected: 12-18 and 20-24.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/NATHAN M CURS/
Primary Examiner, Art Unit 2613

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the Uehara 2x2 switches 17 are not the same as the claimed branching mechanism. This argument is not persuasive. The switches 17 are selectively branching a signal between one path or the other, and thus read on a selective branching mechanism. As for how the claimed branching mechanisms are connected to other elements, those further limitations are addressed by the obviousness rationales.

Applicant argues against the obviousness of the input-side set of switches for Uehara, stating that the rationale is conclusory and has no basis in Uehara. This argument is not persuasive. The rationale is not conclusory; it is based on what would have been obvious to one of ordinary skill in the art considering Uehara's drop channels and the inherent insertion loss of the optical switch element 16. Applicant does not address the rationale as is. Nevertheless, one of ordinary skill in the art would have recognized that any wavelength channels to be dropped at the Uehara fig. 4 node that don't require regeneration (see col. 8 lines 1-11) would still be forced to undergo inherent insertion loss in the element 16 switch since they would still have to pass through it. Given this scenario, and Uehara's existing channels switches 17, no express teaching or suggestion from Uehara is required for the obviousness of the input-side set of switches. Applicant is directed MPEP § 2141.III, which explains rationales to support rejections under 35 USC § 103, and states: "The prior art reference (or references when combined) ***need not teach or suggest all the claim limitations***, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." [emphasis added]. In the rejections above under 35 USC § 103, where the limitations are not explicitly taught in the references, a rationale is provided for why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Nevertheless, Applicant still concludes that there is "no reason" to add the second set of switches; this conclusion dismisses the insertion loss based rationale that is in fact provided .

Applicant also argues that the switches 17 of Uehara are for monitor wavelengths. Applicant is misreading Uehara. The switches 17 are for the main channel wavelengths λ_1 to λ_n . The monitor wavelength, on the other hand, gets its own wavelength λ_{sv} and is routed differently.

Applicant also argues that it would be "non-sensical" to incur the cost and complexity of the second set of switches "to regenerate a monitor-signal when that function is already being performed along the output channels of the same node." This argument is not persuasive. First, the optical switch 16 and channel switches 17 are not for the monitor signal. Second, only the channels that need regeneration get regenerated (col. 8 lines 1-11), yet all drop channels must still pass through optical switch 16 and thus experience inherent insertion loss. Third, since Applicant does not address the insertion loss issue, the argument about addition cost and complexity is unpersuasive because it ignores the benefit gained by reducing insertion loss affecting drop channels.

Applicant also argues that a direct connection for the receiver is not taught or suggested by Uehara and argues that the Office Action dismisses the direct connection difference out of hand. To the contrary, Uehara need not expressly teach or suggest direct connection for it to be obvious, and the Office Action does not dismiss the direct connection issue, but addresses it in the obviousness rationale. Applicant again argues that the Office Action is conclusory with no support by Uehara. This argument is not persuasive since the rejection is not conclusory, it is based on what would have been obvious to one of ordinary skill in the art in light of the drop channels shown by Uehara and minimization of insertion loss, as explained in the rationale.

Applicant also states that Uehara is "conspicuously silent" about a receiver for the drop channel. To the contrary, Uehara starts by discussing conventional WDM systems in the Background section, where Uehara mentions "wavelength components to be received by the respective nodes" (col. 1 lines 29-30). Given each Uehara WDM system "wavelength component" being dropped at the node (col. 8 lines 16-19) it would be non-sensical to conclude that the drop lines are just floating with no receiver. Thus, Uehara is not conspicuously silent, but is merely unconcerned with showing each and every detail of what one of ordinary skill in the art would immediately recognize is necessary for the drop line to having any substance or meaning in Uehara's transmission system. So the issue is only whether direct connection of the receiver would be obvious or not. The rationale for the obviousness of direct connection is not based on Uehara expressly teaching direct connection, nor needed it be (see above). Where the limitations are not explicitly taught in the references, a rationale is provided for why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Applicant does not address the rationale itself.

And regarding direct connection for the transmitters, Applicant states that whether or not there are transmitters connected to the switches is irrelevant. To the contrary, there are transmitters connected and this fact is relevant. Each "wavelength component" being expressly added (col. 8 lines 16-19), by its existence, means there is some kind of transmitter sourcing it. The question is then only about the obviousness of direct connection of such transmitters. For this point, Applicant again alleges that the Office dismisses the deficiency of Uehara in expressly teaching direct connection. To the contrary, the Office Action acknowledge that Uehara does not expressly teach "direct connection." However, the Office Action provides a rationale for the obviousness of direct connection, based on minimizing insertion loss. Applicant dismisses the obviousness conclusion without addressing the rationale on its merits..